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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,060	05/25/2001	James W. Whittaker	HME/8134.003	4178
29085	7590	01/13/2004	EXAMINER	
HOWARD EISENBERG, ESQ. 2206 APPLEWOOD COURT PERKASIE, PA 18944			PAK, YONG D	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/866,060

Applicant(s)

WHITTAKER ET AL.

Examiner

Yong D Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The amendment filed on October 30, 2003, amending claim 21, has been entered.

Claims 1-5, 18 and 20-22 are pending.

Response to Arguments

Applicant's arguments filed on October 30, 2003 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

Claims 1, 3-5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golightly et al. in view of Zamost et al.

Applicants argue that the reference of McAleer et al. should be part of the rejection and is unavailable for use as a reference due to priority dates. The examiner disagrees. First, a reference qualifying under 102 can be used as a reference in a 103 rejection (see MPEP 2141.01).

Second, Zamost et al. teach that methanol is a volatile carbon source and it is readily lost on prolonged incubation and that for protein production, *Pichia* cells are induced with methanol at a temperature of 25-35°C (Column 24, lines 43-63). The reference of McAleer et al. was used to illustrate that altering the temperature during the induction phase to maximize heterologous protein production is well known in the art. Also, lowering the temperature will also decrease proteolytic activity in the cells.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to cool the *Pichia* cells to room temperature when feeding the cells with methanol. The motivation is to maximize protein production.

Claims 1-2 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golightly et al. in view of Zamost et al. as applied to claims 1, 3-5 and 18 above, and further in view of Montague-Smith et al.

Response to applicant's argument regarding the rejection of 1, 3-5 and 18 are discussed above.

Applicants argue that Montague-Smith et al. do teach treatment with an oxidizing agent for 12 hours. The examiner disagrees. Montague-Smith et al. do outline a 15 minute treatment with an oxidizing agent, but Montague-Smith et al. teach that activated galactose oxidase reduces to a mixture of active and inactive forms. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use the rapid method of Montague-Smith et al. or to vary the lengths of treatment time, such as 30 minutes, 1 hour, 2 hours... 12 hours. The motivation of varying the lengths of treatment with the oxidizing agent is to maximize activation of the enzyme.

No claims are allowed.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak
Patent Examiner


PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600